

### **REMARKS**

Claims 1, 2 and 4 to 26 are the pending claims, of which Claims 1, 8, 9, 12 and 16 are the independent claims. Claim 1 is being amended. Reconsideration and further examination are respectfully requested in light of the foregoing amendments and following remarks.

The Office Action rejects Claim 1 under 35 U.S.C. § 112, second paragraph. It is believed that the amendment made to Claim 1 obviates the rejection. Reconsideration and withdrawal of the § 112 rejection are respectfully requested.

By way of a non-limiting example and in accordance with one or more embodiments, a request for media content from a user computer results in the playlist being communicated from a network source, such as a server, to the user computer. The communicated playlist identifies streaming content that includes the media content. In accordance with one or more embodiments and by way of a further non-limiting example, the playlist request includes information used to determine placement of a streaming content item, e.g., streaming advertisement content, in streaming content. To illustrate by way of a non-limiting example, the placement information provided as part of the media content request can include a parameter for use in determining that streaming advertisement content is to be positioned at the beginning or at the end of the streaming content, or somewhere within the media content itself. Depending on the placement information providing with the request, a determination can be made whether the streaming content, e.g., the requested media content, is to include an embedded command that indicates an intermediate point of the media content. By way of yet another non-limiting example and in accordance with one or more embodiments, a command embedded in the streaming content can trigger communication of HTML data that is to be experienced in a data frame at the user computer while the streaming content containing the embedded command is being experienced in a streaming content frame at the user computer.

By the Office Action, Claims 1, 2 and 4 to 26 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,760,916 (Holtz) and U.S. Patent No. 7,111,009 (Gupta). Reconsideration and withdrawal of the rejection are respectfully requested.

While the grounds for rejection cite to Holtz, the Examiner concedes that he is relying on the disclosure of U.S. Application Serial No. 09/634,735 (Snyder) and its August 8, 2000 filing date in order to apply the disclosure of Holtz against the claims of the present application. At the

time that the rejection was first made, Snyder had not yet issued as a patent, and could not be applied against the claims of the present application. In the Applicant's previous response, it was pointed out that Snyder has issued as U.S. Patent No. 7,024,677. In response to the Applicant's previous remarks, the Examiner has stated that:

“[t]he parent application 09/634735 [Snyder] filed 8/8/2000 has been relied upon by the examiner previously in order to demonstrate full support for the teachings used against the instant claims - and will continue to be applied here. Examiner will be referring to page and line number of the specification of 09/634735 in this Office Action.

“Snyder (7024677) was not available at the time the rejections were previously assembled and further, Holtz et al is still valid prior art. Examiner has taken considerable time to reference the supporting subject matter in Holtz et al's non-provisional (09/634735) and will not be re-referencing the same content in the now published patent to Snyder (7024677).”

The Applicant appreciates that it takes time to issue an action, and to formulate grounds for rejection. The Applicant respectfully does not wish to place anymore of a burden on the Examiner than that already required under 35 U.S.C. § 103(a), in accordance with which the Examiner must establish that each and every element of the claims are disclosed by Holtz, the reference that is relied upon, in order to establish a prima facie case of obviousness based on Holtz. In the grounds for rejecting Claims 1, 6, 8, 9, 12 to 14, 16, 19, 20 and 24, the Examiner relies on Holtz and contends that Holtz teaches elements of the claims, but cites to portions of Snyder rather than Holtz as support. For example, the Examiner contends that Holtz teaches “a system [that] creates a “bin” playlist defining the collection of desired clips in a specific order,” and cites a paragraph found at page 70, lines 8 to 23 of Snyder. The Examiner then cites to a paragraph found at page 70, lines 8 to 23 of Snyder, which refers to a “bin” playlist. The Applicant has reviewed Holtz and cannot locate the cited paragraph in Holtz, or any mention of a “bin” playlist in Holtz. The Applicant respectfully renews the request for the Examiner to provide a parallel cite in the Holtz reference that the Examiner considers corresponds to each of the citations to the Snyder reference relied upon by the Examiner, should the Examiner continue to rely on Holtz to reject claims of the present application.

In an effort to advance prosecution and without conceding in any way the propriety of the rejection based on Holtz, the Applicant provides the following remarks with regard to the portions of Snyder identified by the Examiner in the Office Action.

Claim 1 recites a method by which a frame set is built in a browser window, the frame set comprises a media player frame to experience streaming content from a media player executing at said user computer and a data frame. A request is made at a user computer for a playlist to a source on a network. The request includes a streaming advertisement parameter that specifies a position of a streaming advertisement in streaming content. A playlist is received in response to the request. The playlist's contents comprise a reference identifying streaming media content. The playlist or the media content referenced by the playlist including an indicator that indicates when the streaming advertisement should be played in relation to the media content in the streaming content. The user computer connects to at least one media server to request the streaming advertisement and media content from the server. HTML content related to the requested streaming content is received, and the streaming content is simultaneously played in the media player frame as the HTML content is displayed in the data frame.

Snyder describes a video production system that uses stored video production commands to control video production devices. Snyder's show script file stores the video production commands for each segment of a show that is to be produced. Snyder describes an on-demand system which responds to a demand for content by collecting segments of content at the server and then streaming the content from the server to the user computer once all of the content segments have been collected at the server in a "bin" at the server. Snyder's on-demand user does not build a playlist, as suggested in the Office Action, but rather identifies the shows that the user wishes to receive. Furthermore and even if Snyder's show or story file includes "links" to advertisements (a point which is in no conceded), Snyder's show and story files are used to control video production devices, and are not transmitted to, or received at, the user computer. Snyder's show and story files do not correspond to the claimed playlist received at a user computer in response to a request for the playlist, which playlist includes a content reference to streaming media content. Snyder stores streaming content in a "bin", and transmits the streaming content. Nothing in Snyder corresponds to the claimed request for a playlist which includes a streaming advertisement parameter that specifies a position of the streaming

advertisement in streaming content. As is conceded in the Office Action, Snyder's "playlist" consists of the actual streaming content, and Snyder transmits this actual streaming content, not a playlist that references the content. Snyder transmits the content itself, and cannot teach, suggest or disclose receiving a playlist that contains a reference that identifies media content.

Snyder further fails to teach, suggest or disclose that either a playlist or the media content referenced by the playlist includes an indicator that indicates when streaming advertisement should be played in relation to the media content. In the Office Action, the Examiner contends that an advertisement is merely an "announcement or message delivered to members of the public", and is no different from "any of the content shown to the user." An advertisement is not like content, (e.g., an advertisement shown during a TV show is not the TV show). Both Snyder and Holtz clearly differentiate between an advertisement and media content selected by the user. An advertisement is promotional content that is an add-on to other content that a user has indicated a desire to experience, and is typically intended to persuade a viewer/consumer to purchase something, such as a product or service which is the subject of the advertisement. In Snyder, content selected by the user is used to attract an audience for an advertisement (see Snyder, pg. 12, lns. 7 to 13). In Holtz, the reference actually applied in the formal grounds for rejection, advertisements are their own source of revenue, and a discrete advertisement system is used to collect information for the advertisements, which is used to determine advertisement income generated and to apportion the income generated from advertisements. According to Holtz' Abstract:

The media production is displayed on the client with various media enhancements to add value to the media production .... The enhancements also include advertisements, such as commercials, active banners, and sponsorship buttons. An advertisement reporting system monitors the sale and distribution of advertisements within the network. The advertisements are priced according to factors that measure the likelihood of an advertisement actually being presented or viewed by users most likely to purchase the advertised item or service. The advertisement reporting system also collects metrics to invoice and apportion income derived from the advertisements among the network participants, including a portal host and/or producer of the content.

There is clearly a distinction in both Snyder and Holtz between media content and advertisements. Furthermore, according to Snyder, the position/placement of an advertisement is determined at the time of the original broadcast of the show, well in advance of a user's selection of the show for on-demand viewing. As discussed in Snyder commencing at pg. 68, ln. 19, the user can make an on-demand selection of media content previously broadcast, so that the selected media content can be streamed to the user's computer. According to Snyder, an advertisement can be streamed to the user's computer as well, using the script file created at the time of the original broadcast of the media content. According to Snyder, advertisements are loaded, placed and played according to icon placements in the script file created at the time of the original broadcast. The position/placement of the advertisement for on-demand broadcast of media content in Snyder is therefore determined at the time of the original broadcast of the media content. In contrast, according to the present claims, a streaming advertisement parameter included in a request for a playlist specifies a position of a streaming advertisement.

Gupta has been reviewed and is not believed to remedy the deficiencies of Snyder. Gupta provides a user interface that displays annotations, i.e., titles or summaries of video segments, and allows the user to select a segment by the segment's title or summary. According to Gupta, the user can identify the set of annotations to be displayed using a query, and the user interface displays the queried annotations. Gupta fails to even mention making a playlist request at a user computer, and further fails to disclose or suggest a playlist request that includes a streaming advertisement parameter that specifies a position of the streaming advertisement in streaming content, and/or receiving a playlist received in response, which contains a reference identifying media content, either the received playlist or the media content referenced in the received playlist including an indicator that indicates when the streaming advertisement should be played in relation to the media content.

Since Snyder and Gupta fail to teach, suggest or disclose multiples ones of the same elements of Claim 1, neither Snyder nor Gupta can form a proper § 102 rejection, and they also cannot form the basis of a proper § 103(a) rejection alone or in any combination with or without Holtz, as no combination teaches, suggests or discloses all of the elements claimed.

Claim 1 is therefore believed to be patentably distinct from Snyder and from Gupta. Claims 2 and 4 to 7 depend from Claim 1 and are believed to be patentably distinct from Snyder

and Gupta for at least the same reasons discussed above with respect to Claim 1. In addition, Claims 2 and 4 to 7 recite additional elements that are not taught, suggested or disclosed by Snyder.

Claim 2 further recites that the receiving of HTML content includes providing the HTML content related to streaming content being experienced in a media player frame in a data frame in response to execution of an embedded command in the streaming media content. Claim 5 recites that an embedded script command is received in the streaming content requested using the references in the playlist. The embedded script command references the remotely-stored HTML content that is related to the streaming content requested using the playlist's references and that is being experienced in the browser window. The Office Action cites to Holtz, but appears to reference a portion of Snyder. As with the "bin" playlist discussed above, the referenced portion of Snyder, which mentions "datacasting" does not appear to be included in Holtz. The cited portion of Snyder mentions "datacasting", but does not provide any description of how the datacasting is performed, and certainly does not mention, let alone disclose or even suggest embedding a command into streaming content, and nothing in Snyder teaches, suggests or describes a command embedded in streaming content such that related HTML content is provided in a data frame. Furthermore, Snyder fails to teach, suggest or describe a script command embedded in streaming content that references HTML content related to streaming content.

Claim 6 further recites that the indicator included in a playlist or the media content referenced by the playlist indicates whether the advertisement is to be played before, during or after the media content referenced in the playlist. As discussed above, Snyder's show and script files consist of video production commands, and do not correspond in any way to the claimed playlist. The Office Action fails to provide any reference to any portion of Snyder, and none can be found, that teaches, suggests or describes indicator included in a playlist that references streaming media content or included in the streaming media content referenced by the playlist indicating whether an advertisement is to be played before, during or after media content.

Independent Claims 8 and 9, and Claims 10 and 11 which depend from Claim 9, are believed to be patentably distinct over Snyder for at least the foregoing reasons.

Independent Claim 12 recites a method comprising receiving a request for a playlist, the request including a streaming advertisement parameter, which specifies a position of the streaming advertisement in streaming content, building a playlist, the contents of which comprise a reference identifying streaming media content, the parameter included in the received request being used to determine which of the playlist and the media content referenced by the playlist includes an indicator that indicates when the streaming advertisement should be played in relation to the media content, and transmitting the playlist to a user computer.

Independent Claim 16 recites a method that receives a request for a playlist from a user computer, the request including advertisement placement information, builds a playlist using the advertisement placement information such that the playlist includes a reference to streaming content, which has at least one embedded command including advertisement identification information to be processed as the streaming media content is being experienced at said user computer, and transmits the playlist to the user computer.

As discussed above, Snyder is limited to collecting content in a bin at the server. Snyder does not build a playlist containing a reference to streaming content that is transmitted to a user computer, and further fails to teach, suggest or disclose such a playlist that has at least one embedded command that includes advertisement identification information to be processed as the streaming content is being experienced at the user computer. Gupta focuses on providing a user interface to display segment annotations so that the user can select a segment by selecting the segment's annotation. Neither Snyder nor Gupta builds a playlist in response to a request that includes a streaming advertisement parameter (Claim 12) or advertisement placement information (Claim 16). Neither Snyder nor Gupta uses, in building the requested playlist, the streaming advertisement parameter that is included in the playlist request to determine which of the playlist or the media content that is referenced by the playlist includes an indicator that indicates when the streaming advertisement should be played in relation to the referenced media content. Furthermore, neither Snyder nor Gupta uses advertisement placement information included in a playlist request to build the playlist to include a reference to streaming content, which has at least one embedded command including advertisement identification information to be processed as the streaming-content is being experienced at said user computer.

Claim 13, which depends from Claim 12, further recites that information contained in a request for a playlist includes information that identifies a location of information to configure a frame set on a user computer to which the playlist is sent. Snyder's on-demand system focuses on responding to a demand for content by streaming content, and nothing in Snyder teaches, suggests or describes a request for a playlist, the request including information that identifies a location of information to configure a frame set on a user computer.

In view of the above reasons provided in connection with the claims, both independent and dependent, discussed above, independent Claims 12 and 16, and Claims 13 to 15 (which depend from Claim 12) and Claims 17 to 26 (which depend from Claim 16), are believed to be patentably distinct from Snyder.

Since Snyder and Gupta are missing multiple elements of the claims, neither can form the basis of a proper § 102 rejection, and further since they are missing multiple ones of the same claim elements, they cannot form the basis of a proper § 103(a) rejection. The claims should therefore be patentable over the references. Furthermore and since Snyder is missing multiple elements of the claims, Holtz, which must necessarily rely on the disclosure of Snyder in order to even be considered to be prior art, cannot form the basis of a proper § 102 rejection, and further cannot form the basis of a proper § 103(a) rejection. Withdrawal of the § 103(a) rejection of the claims is proper, and is respectfully requested.

In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney. Alternatively, since it is believed that the claims of the present application are in condition for allowance, the Examiner is respectfully requested to issue a Notice of Allowance at the Examiner's earliest convenience.

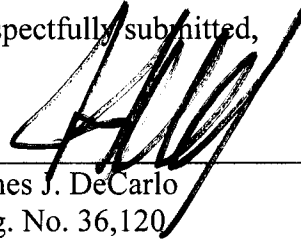
The applicant's attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address given below, which is the address associated with Customer Number 76058.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or



credit any overpayment to Account No. 50-1561. Please ensure that the Attorney Docket Number is referenced when charging any payments or credits for this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. DeCarlo', is written over a horizontal line.

James J. DeCarlo  
Reg. No. 36,120

Date: November, 6, 2008

Customer Number 76058  
GREENBERG TRAURIG, LLP  
Met Life Building  
200 Park Avenue, 34<sup>th</sup> floor  
New York, New York 10166  
Phone: (212) 801-9200  
Fax: (212) 801-6400